

## REMARKS

Applicants acknowledge receipt of the Office Action dated September 28, 2010, in which the Examiner rejected claims 1-3 and 5-8 as anticipated by Bailey (US 6098717); rejected claims 1-3 and 5-8 as anticipated by Nguyen et al. (US 7048048); rejected claims 1-3 as anticipated by Brezinski et al. (US 2005/0092485); rejected claims 4 as obvious in view of Bailey or Nguyen; rejected claims 9-10 as obvious in view of Bailey or Nguyen in view of Metcalfe (US 6457533); rejected claims 12-14 as obvious in view of Bailey or Nguyen in view of Kirk (7096939).

Applicants have amended the claims and respectfully submit that the case is now in condition for allowance for the reasons set out below.

### Rejection of claims 1-3 and 5-8 as anticipated by Bailey

In the passages supporting this rejection, the Examiner acknowledges that the Bailey discloses **neither** that the expandable tubular element shortens as a result of radial expansion thereof, **nor** first and second portions that move toward each other when the tubular element is expanded, **nor** a third portion that is radially expanded more than the tubular element. Applicant respectfully submits that **none** of the missing elements is inherent in the Bailey device and that Bailey fails as an anticipating reference.

First, it is **not true** that metal tubulars inherently shorten to some degree when radially expanded. As indicated in the previously submitted *Responses*, it is entirely possible that radial expansion of a tubular can occur without axial shortening. In instances where radial expansion occurs without axial shortening, wall thinning will occur. Bailey makes no mention, suggestion, or indication, graphic or verbal, that shortening occurs and Applicant respectfully submits that it is improper to base a § 102 rejection on the alleged occurrence of shortening in Bailey.

Second, nothing in Bailey suggests that outer structure 16 has first and second portions that are “connected to the tubular element at respective locations axially spaced from each other such that the distance between the first and second portions changes during radial expansion of the tubular element between the first and second portions” as required in claim1. The Office Action states that the outer structure of Bailey is “securely held at the first and second ends,” but Applicant sees no support for that assertion.

Lastly, nothing in Bailey suggests that any portion of outer structure 16 will expand radially more than the tubular element. In the drawings, body 18 of structure 16 (which is mis-labeled in Fig. 2) is undeformed and remains conformed to the outer surface of tubular 14 after expansion. In fact, since structure 16 is not affixed to tubular 14, it can be expected that the axial distance between the first and second ends of structure 16 will be unaffected by the axial length of the adjacent portion of tubular 14, therefore placing the Bailey device wholly outside the scope of the present claims.

Because each of the three expressly-claimed features of claim 1 is completely missing from Bailey, Applicant respectfully requests that this rejection be reconsidered and withdrawn. Further, because the dependent claims depend from claim 1 and recite further features, the rejection of the dependent claims is also deficient for the reasons set out above.

Rejection of claims 1-3 and 5-8 as anticipated by Nguyen et al.

With respect to Nguyen, applicant respectfully re-states the arguments made above with respect to Bailey. Nguyen relates to a sand screen. Like Bailey, and as acknowledged in the Office Action, Nguyen does not teach shortening of the inner tubular, connection of the outer structure in the claimed manner, or radial movement of the outer structure as a result of shortening of the inner tubular. As with the preceding rejection, the characterization of Nguyen that is used to support the rejection is based solely on conjecture and finds no basis in the reference itself or in known technological aspects thereof.

Because each of the three expressly-claimed features of claim 1 is completely missing from Nguyen, Applicant respectfully requests that this rejection be reconsidered and withdrawn. Further, because the dependent claims depend from claim 1 and recite further features, the rejection of the dependent claims over Nguyen is also deficient for the reasons set out above.

Rejection of claims 1-3 as anticipated by Brezinski et al.

In support of this rejection, the Office Action repeats the assertions made with respect to Bailey and Nguyen. In response to the first of these, Applicant repeats the foregoing argument, namely that shortening of metal tubulars upon radial expansion is not inherent.

With respect to the assertion that Brezinski teaches an outer structure connected to the inner tubular element, Applicant respectfully submits that element 60 in Brezinski is not connected to

tubular 54. Rather element 60 is *slidable* along the outside of the tubular and is merely held in place by locking recess 62 (in order to retain elastomeric sleeve 56 in a stretched condition). As soon as the locking recess is removed by expansion, element 60 slides along the outside of the tubular. Thus, the axial distance between the first and second ends of structure 56 is unaffected by the axial length of the adjacent portion of tubular 14.

Nonetheless, in order to clarify this distinction, Applicant has amended claim 1 to require that the first and second portion of the outer structure are connected to the tubular element “throughout radial expansion of the tubular element.”

Applicant submits that claim 1 is allowable over Brezinski for all of the foregoing reasons. Further, because the dependent claims depend from claim 1 and recite further features, the rejection of the dependent claims over Brezinski is also deficient for the reasons set out above.

#### Rejection of claims 4 as obvious in view of Bailey or Nguyen

Because neither Bailey nor Nguyen teaches affixing the ends of outer structure to the inner structure, there would be no reason to modify those references to include welded connections. In addition, both references are missing other elements of the claims. Therefore, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

#### Rejection of claims 9-10 as obvious in view of Bailey or Nguyen in view of Metcalfe

Because the dependent claims depend from claim 1 and recite further features, Applicant respectfully traverses this rejection is for the reasons set out above.

#### Rejected claims 12-14 as obvious in view of Bailey or Nguyen in view of Kirk

Because the dependent claims depend from claim 1 and recite further features, Applicant respectfully traverses this rejection is for the reasons set out above

#### Conclusion

Applicant believes he has addressed every issue raised by the Examiner in the Office Action. Because no new matter has been entered and because the case is now in condition for allowance, Applicant respectfully requests the Examiner to enter the amendments and allow the

case. If it would be considered helpful in resolving any issues in the case, the Examiner is encouraged to contact the undersigned at the number below.

Respectfully submitted,

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